

### **REMARKS/ARGUMENTS**

In the outstanding Office Action, the Examiner rejected claims 1-4, 7-10 and 12-21 and objected to claims 5, 6 and 11. By this amendment, Applicants cancel claims 1-4, 7-9, and 18-21 without prejudice or disclaimer, amend claims 5, 10-12, and 16 and add new claims 22-26. Specifically, claims 5 and 11 have been rewritten in independent form, as suggested by the Examiner. Additionally, claims 22-26 rewrite claims 3, 4, and 7-9 to depend from claim 5, as amended. Claims 5, 6, 10-17, and 22-26 are pending and under consideration.

#### **Regarding the Specification**

Portions of the specification were textually edited to enhance readability of the overall patent application. These changes do not introduce new matter.

#### **Rejection of Claims 11 and 18-21 Under 35 U.S.C. § 112**

The Examiner rejected claim 11 under 35 U.S.C. § 112 because the claim depended from itself. Applicants amend claim 11 into independent form, incorporating all of the limitations of claim 1. It is respectfully submitted that amended claim 11 corrects this typographic error.

The Examiner rejected claims 18-21 under 35 U.S.C. § 112 because they allegedly lacked an enabling disclosure. Applicants cancel claims 18-21 without prejudice or disclaimer. Applicants respectfully submit that this cancellation renders the rejection of claims 18-21 moot.

#### **Rejection Under 35 U.S.C. § 102(a) of Claims 1-4, 7-9, and 18-21**

The Examiner rejected claims 1-4, 7-9 and 18-21 under 35 U.S.C. § 102(a) as allegedly being anticipated by U.S. Pat. No. 6,287,128 to Jones, et al. ("Jones"). Office Action at pages 3-4. Applicants cancel claims 1-4, 7-9 and 18-21 without prejudice or disclaimer. Accordingly, Applicants submit that this cancellation renders this rejection moot.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Rejection Under 35 U.S.C. § 102(b) of Claims 1-3, 7-8, 10, 12-13, and 18-21

The Examiner rejected claims 1-3, 7-8, 10, 12-13 and 18-21 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Pat. No. 5,230,030 to Hartman, et al. ("Hartman"). Office Action at pages 4-5. Initially, as stated above, Applicants cancel claims 1-4, 7-9 and 18-21 without prejudice or disclaimer. Accordingly, rejection of claims 1-3, 7-8 and 18 to 21 are rendered moot, leaving outstanding rejections to claims 10, 12 and 13.

Applicants respectfully traverse rejection of claims 10, 12 and 13. Claim 10, as amended, recites, in part, "[a]n optical transceiver, comprising a housing mountable on a board with a portion of the housing above a plane of the board and a second portion of the housing below the plane of the board..." Initially, it is unclear what the Examiner construed as the board in Hartman. It appears that the Examiner construes the base 15 in Fig. 1 of Hartman as both a base and a board. Office Action at page 4, paragraphs 4 and 7. While Hartman teaches that "[m]ultichip module 10 includes a plurality of semiconductor chips 14 (ICs) mounted on a base 15, which is at least partially formed from a printed circuit board", it does not teach where the board is located within the base. (Col. 2, lines 5-8, see Fig. 1).

Notwithstanding, the Examiner construed Hartman to teach a board 15. According to the Examiner, the board 15 is placed in the plane on the top surface of the base 15 (i.e., the surface at the top of the keyway pointed towards the viewer in Fig. 1). Under this construction, when what the Examiner construed as housing 22 is slid into keyway 20, the top surface of housing 22 (i.e., opposite of surface 27) is flush with the surface defining board 15. Accordingly, Hartman does not teach that the housing has a "portion of the housing *above* a plane of the board..." as recited by claim 10, as amended (emphasis added). As a result, Hartman does not teach or disclose each and every limitation of claim 10. MPEP 2131.

Claim 12, contains the same limitation discussed above for claim 10. Specifically, claim 12 as amended, recites, in part, "[a]n optical transceiver, comprising a housing mountable on a board *with a portion of the housing above a plane of the board* and a second portion of the housing below the plane of the

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

board..." (emphasis added). Accordingly, this claim is allowable for at least the same reasons discussed above for claim 10.

Claim 13 depends from claim 12. Thus, this claim is allowable for at least the same reasons discussed above for claim 12.

Rejection Under 35 U.S.C. § 102(e) of Claims 1, 16-18, 20, and 21

The Examiner rejected claims 1, 16-18, 20, and 21 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Pat. No. 6,508,595 to Chan, et al. ("Chan"). Office Action at page 5. Initially, as stated above, Applicants cancel claims 1-4, 7-9 and 18-21 without prejudice or disclaimer. Accordingly, rejection of claims 1, 18, 20, and 21 are rendered moot, leaving outstanding rejections to claims 16 and 17.

Applicants respectfully traverse rejection of claims 16 and 17. Claim 16, as amended, recites, in part, "[a]n optical transceiver, comprising a housing mountable on a circuit board with a portion of the housing above a plane of the circuit board and *a second portion of the housing below the plane of the circuit board...*" (emphasis added). Chan teaches that the optic assemblies 20, 22 electrically connect with the laminate board 93, instead of the overmold frame 18. Indeed, Chan teaches that the overmold frame merely functions as a standoff to space the optical assemblies 20, 22 away from the laminate board 93 to optimize the width of gaps 96 and 92 and thus effectuate "efficient heat transfer". (Col. 4, line 4, see Figs. 5 and 14). Accordingly, the overmold frame 18 is not a circuit board. As Fig. 5 clearly shows, Chan teaches the housing 27 mounted solely above the laminate board 93. Accordingly, Chan does not teach "a second portion of the housing below the plane of the *circuit board*", as recited by claim 16, as amended (emphasis added). As a result, Chan does not teach or disclose each and every limitation of claim 16. MPEP 2131.

Claim 17 depends from claim 16. Thus, this claim is allowable for at least the same reasons discussed above for claim 16.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Rejection Under 35 U.S.C. § 103(a) of Claims 14 and 15

The Examiner rejected claims 14 and 15 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Pat. No. 5,230,030 to Hartman, et al., ("Hartman"). Office Action at page 6.

Applicants respectfully submit that the amendment to claim 12 renders this rejection moot. Claims 14 and 15 depend from claim 12. Thus, these claims are allowable for at least the same reasons discussed above for claim 12.

Applicants acknowledge the requirement of 37 CFR § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made.

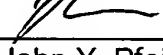
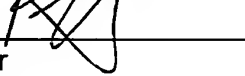
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: August 15, 2003

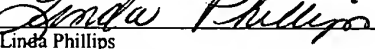
By:    
John Y. Pfeifer  
Reg. No. 52,120

CERTIFICATE OF EXPRESS MAILING

Express Mail Label No.: EV 351294443 US

I hereby certify that this correspondence is being deposited with the United States Postal Services "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10, addressed to: Mail Stop Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below.

Date August 15, 2003

Signed:   
Linda Phillips

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com